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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/537,816

06/07/2005

Jean-Noel Thorel

124184

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09/16/2008

OLIFF & BERRIDGE, PLC

P.O. BOX 320850

ALEXANDRIA, VA 22320-4850

EXAMINER

CLAYTOR, DEIRDRE RENEE

ART UNIT

PAPER NUMBER

1617

MAIL DATE

DELIVERY MODE

09/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/537,816

Applicant(s)

THOREL ET AL.

Examiner

Renee Claytor

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 July 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 8-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7, 17-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE-US)
Paper No(s)/Mail Date 11/8/2005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Election/Restriction

Applicant's election with traverse of the biomimetic peptide histidine- β -alanyl in the reply filed on 7/7/2008 is acknowledged. The traversal is on the ground(s) that the Office fails to show a lack of unity of invention among the biomimetic peptides. This is not found persuasive because each biomimetic peptide would require a different search because the different types of biomimetic peptide include dipeptides, tripeptides, tetrapeptides, pentapeptides, and hexapeptides which would require an extensive search for each different type of peptide.

The requirement is still deemed proper and is therefore made FINAL.

Accordingly, claims 1-7 and 17-22 are being examined herein because they read on the elected species.

Claim Rejections – 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Regarding claims 1, 17-18, the phrase "for example" renders the claim indefinite because it is unclear whether the limitation(s) following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claim 20 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant

regards as the invention. It is unclear what the cosmetic active principle potentiated by the bioactive system is referring to.

Claim Rejections – 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7 and 17-22 rejected under 35 U.S.C. 103(a) as being unpatentable over Tur (US Patent 4,844,884) in view of Degwert et al. (US Patent 5,723,482).

Tur teach cosmetic compositions comprised of ATP (Col. 2, lines 31-50). It is taught that the adenosine compounds that are particularly suitable include disodium salt of ATP (Col. 3, lines 62-66). Examples 1-5 exemplify compositions with ATP ranging from 0.04% to 0.1% by weight, which falls within the range taught in claim 22. Further Tur teaches the addition of the amino acid tyrosine and protein hydrolyzate in the cosmetic composition (meeting the limitations of claims 17-18; Col. 2, lines 63-68 - Col. 3, lines 1-25 and the examples). Tur teaches that the invention can be in the form of an emulsion (Col. 5, lines 52-58).

Tur does not teach compositions comprising an ATP precursor or a biomimetic peptide.

Degwert et al. teach cosmetic and dermatological formulations comprised of carnosine, which is another name for histidine- β -alanyl (Col. 2, lines 18-26). The functional activity of the biomimetic peptide as listed in claims 3 and 4 is considered a property of the biomimetic peptide, in this case carnosine. It is noted that a compound and its properties are inseparable. In re Papesch, 315 F.2d 381, 137 USPQ 43 (CCPA 1963). Degwert et al. teach that carnosine is present in the composition in a preferable amount of 0.1% by weight to 6% by weight (meeting the limitation of claim 19; Col. 4, lines 28-30). Degwert et al. teaches that the formulations can be in the form of emulsions, including water-in-oil and oil-in-water types (meeting the limitation of claim 21; Col. 5, lines 23-29). Example 21 teaches that carnosine is dissolved in water, meeting the limitation of the bioactive system being included in the aqueous phase in claim 21.

It is prima facie obvious to combine two compositions each of which is taught by the prior art to be useful for the same purpose, in order to form a third composition to be used for the very same purpose. The idea of combining them flows logically from their having been individually taught in the prior art. In re Kerkhoven, 626 F.2d 846, 205 USPQ 1069, 1072 (CCPA 1980). One would be motivated to combine the ATP taught by Tur with carnosine as taught by Degwert et al. in the treatment of skin conditions.

Conclusion

No claims are allowed.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Renee Claytor whose telephone number is (571)272-8394. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 571-272-0629. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Renee Claytor

/SREENI PADMANABHAN/
Supervisory Patent Examiner, Art Unit 1617